

## **REMARKS/ARGUMENTS**

This response addresses items brought up by the examiner in the final Office action. Additionally, Applicant respectfully requests actions absent from the final Office action under 37 C.F.R. § 1.104 (c) 2 and MPEP 706.07(a), as discussed below. Claims 1-10 are pending, without amendment. Claims 11-15 have been withdrawn. In view of the following remarks, reconsideration of this Application is respectfully requested.

### *Rejections under 35 U.S.C. §102 in view of U.S. Patent No. 5,827,321 to Roubin*

Claims 1-4 and 9-10 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,827,321 to Roubin *et al.*, hereinafter "Roubin." Applicant respectfully traverses this rejection because Roubin fails to teach all the elements of the claims. In particular, claim 1 requires a stent comprising, in part, both a compressed configuration and an expanded configuration, the configurations having limitations as follows:

A compressed configuration having a generally constant diameter and a pattern density adjacent the first end that is greater than a pattern density adjacent the second end.

An expanded configuration having a transverse dimension at the first end that is larger than a transverse dimension at the second end and having a pattern density adjacent the first end that is substantially equal to a pattern density adjacent the second end.

The examiner has cited Roubin FIGS. 3, 9 and 10 as disclosing all the elements of claim 1. Specifically, the claim limitations regarding pattern density of the compressed configuration are cited as being seen in FIG. 10. However, "FIG. 10 is a side elevational view of a portion of the stent of FIG. 3 illustrating a modification thereto (column 4, lines 49-50)," and "A stent 40 according to the present invention is illustrated in FIGS. 3-6 in its expanded state (column 5, lines 24-25, emphasis provided)." Thus, FIG. 10 cannot be considered to teach the compressed configuration of claim 1 because FIGS. 3-6 and 10 illustrate an expanded configuration, not a compressed configuration. Applicant

maintains that nowhere does Roubin teach the limitations in claim 1 regarding the compressed configuration.

Additionally, the claim limitations regarding pattern density of the expanded configuration are cited as being seen in FIG. 9. However, "FIG. 9 is a side elevational view of a portion of the stent of FIG. 3 illustrating a modification thereto (column 4, lines 47-48)." FIG. 3 illustrates a non-tapering, or constant-diameter, cylindrical stent. Thus, FIG. 9 cannot be considered to teach the expanded configuration of claim 1 because FIGS. 3-6 and 9 illustrate an expanded cylindrical configuration, not a "configuration having a transverse dimension at the first end that is larger than a transverse dimension at the second end," as claimed, in part. Roubin only illustrates tapered stents 40a-40c in FIGS. 11A-11C, respectively, wherein the stent pattern density is shown to vary according to the diameter of the stent portion, thus not teaching the claims of the instant invention. Applicant maintains that nowhere does Roubin teach the limitations in claim 1 regarding the expanded configuration. In view of the above remarks, Roubin cannot be considered to anticipate claim 1 because the reference fails to teach at least two of the elements of claim 1.

Claims 2-4 depend directly or indirectly from claim 1 and are patentable for at least the reasons stated above. Furthermore, the Examiner has failed to point out any part of Roubin that is considered to teach the specific limitations of claim 2, as required under 37 C.F.R. § 1.104 (c) 2.

Claim 9 depends from claim 1 and includes the further limitation, in part, of "each hoop element being axially coupled to an adjacent hoop element through one or more adjoining crowns." Roubin does not teach a stent having one crown adjoining another crown. Instead, Roubin teaches crowns being linked together by connecting members 49. Thus, for this reason, and for at least the reasons discussed above with respect to claim 1, Roubin fails to anticipate claim 9.

Claim 10 depends from claim 9 and is patentable over Roubin for at least the reasons discussed above with respect to claim 9. For the foregoing reasons, Applicant requests that the above rejections under 35 U.S.C. §102 in view of Roubin be withdrawn.

*Rejections under 35 U.S.C. §102 in view of U.S. Patent No. 5,957,949 to Leonhardt et al.*

Claims 1-4 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,957,949 to Leonhardt *et al.*, hereinafter "Leonhardt." Applicant respectfully traverses this rejection because Leonhardt fails to teach all the elements of the claims. In particular, claim 1 requires a stent comprising, in part, both a compressed configuration and an expanded configuration, the configurations having limitations as follows:

A compressed configuration having a generally constant diameter and a pattern density adjacent the first end that is greater than a pattern density adjacent the second end.

An expanded configuration having a transverse dimension at the first end that is larger than a transverse dimension at the second end and having a pattern density adjacent the first end that is substantially equal to a pattern density adjacent the second end.

The Examiner states that Leonhardt discloses

"... the compressed configuration has a pattern density adjacent the first end (20 as best seen in fig. 4) that is greater than a pattern density adjacent the second end (46 as seen in fig. 4).

Applicant respectfully disagrees with the above characterization of Leonhardt. In column 3, lines 35-39, Leonhardt states that "the top and bottom portions are substantially symmetrical to each other having a zig-zag 40 or wavy form. The preferred embodiment has six (6) zig-zags . . ." In FIG. 4, valve stent 20 is shown with equal numbers of distensible fingers 46 formed by zig-zag fingers 40 of stent 26. Thus, Leonhardt fails to

teach the “compressed configuration having a generally constant diameter and a pattern density adjacent the first end that is greater than a pattern density adjacent the second end,” as required, in part, by claim 1.

Regarding Leonhardt, the Examiner also states

“Note that the expanded configuration has a transverse dimension at the first end that is larger than a transverse dimension at the second end (fig. 4). . .”

Applicant respectfully avers that it is improper to cite single figure 4 in the reference as teaching both the compressed and expanded stent configurations as required in claim 1. FIG. 4 cannot be considered to teach the expanded configuration of claim 1 because FIG. 4 illustrates a non-tapering, or constant-diameter, cylindrical stent, not a “configuration having a transverse dimension at the first end that is larger than a transverse dimension at the second end,” as claimed, in part. Applicant maintains that nowhere does Leonhardt teach the limitations in claim 1 regarding the expanded configuration. In view of the above remarks, Leonhardt cannot be considered to anticipate claim 1 because the reference fails to teach at least two of the elements of claim 1.

Claims 2-4 depend directly or indirectly from claim 1 and are patentable for at least the reasons stated above. For the foregoing reasons, Applicant requests that the above rejections under 35 U.S.C. §102 in view of Leonhardt be withdrawn. Furthermore, Applicant raised arguments regarding Leonhardt in the Reply filed on November 18, 2004, and the final Office action has failed to rebut these arguments as it should have in accordance with MPEP 706.07(a).

#### *Allowable Subject Matter*

Applicant gratefully acknowledges the Examiner’s indication that claims 5-8 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

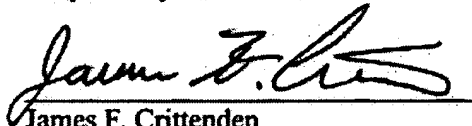
Expedited Processing  
Application No. 10/060,206  
Final Office Action Dated: February 24, 2005  
Reply to Final Office Action mailed April 21, 2005

**Conclusion**

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (978) 739-3075 (EST).

Dated: April 21, 2005

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "James F. Crittenden", is written over a horizontal line.

James F. Crittenden  
Registration No. 39,560  
Agent for Applicant

Medtronic Vascular, Inc.  
3576 Unocal Place  
Santa Rosa, CA 95403  
Facsimile No.: (707) 543-5420